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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,420	01/18/2002	John P. Hunter JR.	HUNTER PRODUCT-DIVISIONAL	4104
4988	7590	05/21/2004	EXAMINER	
ALFRED M. WALKER 225 OLD COUNTRY ROAD MELVILLE, NY 11747-2712			YAO, SAMCHUAN CUA	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	10/052,420	Applicant(s)	HUNTER, JOHN P.
Examiner	Sam Chuan C. Yao	Art Unit	1733



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 08 March 2004.  
2a) This action is **FINAL**.      2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 42-46 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 42-46 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 42-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to give proper guidance to the artisan, wishing to practice applicant's claimed invention, as to how one can effectively apply a polyurethane foamable with a reinforcing mesh using a vehicle foam applicator onto a base surface of a roof without forming a seam to a cured polyurethane foam. Any attempt to form a seamless cured polyurethane foam on a whole base surface of a roof using applicant's vehicle foam applicator would involve mere guesswork and undue experimentation on the part of the artisan.

It would appear to be extremely difficult, if not impossible, to maneuver applicant's vehicle foam applicator without performing the following sequence of steps: a) applying a foamable resin to a segment of a base surface of a roof, b) curing the foamable resin segment, and then repeating process steps a and b until a whole base surface of the roof is covered with the foam. By performing

these process steps, a seam would appear to intrinsically be formed between adjacent segments.

3. Claims 42-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As far as the Examiner can tell, no express support can be found for the newly added limitation “a seamless solidified cure polyurethane foam ...” (emphasis added) per claim 42, without any guidelines/guidance from Counsel/Applicant as to where support might be found, this engenders a New Matter situation.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 42-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marchais et al (US 4,558,550) in view of Beard et al (US 3,815,301).

Marchais et al, drawn to an insulating foam roof covering, substantially discloses the recited combination in claims 42-43 and 45. Although not explicitly disclosed, one reading the disclosure of Marchais et al as a whole would have reasonably

understood and recognized that, a whole base surface of a roof is covered with an insulating foam roof covering as evidence from the following passage: "*there is obtained a fluidtight and insulating covering*" in a construction of a roofing (col. 1 lines 5-59). In any event, such would have been obvious in the art, because a) in order to form a fluidtight insulating foam roof covering, it would be imperative for one in the art to completely cover a base surface of a roof with the foam roof covering; and, b) it is a common practice in the art to completely cover a base surface of a roof with a foam sealing layer as exemplified in the teachings of Beard et al (abstract; col. 2 lines 17-19). Moreover, although not explicitly disclosed, an insulating foam roof covering applied on a base surface of a roof would appear to be seamless, since the roof covering is applied on site. In any event, such would have been obvious in the art as such is old in the art as exemplified in the teachings of Beard et al (col. 2 lines 14-19; figure). Note the passage "... *the entire roof is sprayed with polyurethane foam, and when this foam sets, the entire roof is sealed into one integral unit*" (col. 2 lines 14-19) and figure 1 (foam sealing layer appears to be seamless). The incentive for one in the art in forming a seamless foam covering would have simply been to obtain the self-evident advantages of enhancing the aesthetic appearance of a resultant foam roof covering and ensuring fluidtight\seal (i.e. no opportunity for a fluid to leak into seam(s) of a foam roof covering).

Marchais et al is also silent on the material used in forming a foam roof covering. However, it would have been obvious in the art to use a polyurethane foamable

resin as such is notoriously well known effective roof covering/sealing material in the art as exemplified in the teachings of Beard et al (abstract).

With respect to claim 44, it is conventional in the art to embed a reinforcing thermoplastic mesh into a foam layer.

With respect to claim 46, it is conventional in the art to provide an impervious layer onto a foam roofing sheet to protect the foam sheet from adverse environmental conditions such as rain, snow, etc.

***Response to Arguments***

3. Applicant's arguments with respect to claim 42 has been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

4. Jones et al (US 5,468,293) is cited as reference of interest show a portable resin emulsion spray gun for applying on-site a covering layer onto a roof surface.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sam Chuan C. Yao  
Primary Examiner  
Art Unit 1733

Scy  
05-06-04